

REMARKS/ARGUMENTS

In response to the Office Action mailed March 8, 2004, Applicant responds as follows:

I. PRIOR ART MATTERS

- A. The Office Action rejected claims 1-22 under 35 USC 103(a) as being unpatentable over Ichbiah in view of Goldwasser. Applicant respectfully traverses the rejection.

The Examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness.¹ If the Examiner does not produce a *prima facie* case, the applicant is under no obligation to submit evidence of non-obviousness.²

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure.³

Applicant respectfully traverses the § 103 rejection because the Office Action has not established a *prima facie* case of obviousness.

The reference does not teach or suggest all the claim limitations.

Specifically as to claim 1, neither reference discloses the step:

c) selecting a word in the text to be converted to an abbreviation and converting the selected word to a corresponding abbreviation using the first data structure;

Applicant respectfully disagrees with the Office Action's statement that:

¹ MPEP Sec. 2141.

² Id.

³ Id. (emphasis supplied)

Recognizing the sequence of keypresses typed of a word that has a corresponding abbreviation according to the stored list of words and corresponding abbreviation; said recognizing inherently indicates that said word in the entered text is selected for converting to abbreviation based the stored list in memory...

Goldwasser does not teach "selecting" a word in the text to be converted to an abbreviation. Rather, Goldwasser discloses a method of teaching a computer user the abbreviations of words, phrases, and command sequences to remind the user of the existence of the abbreviation whenever the user neglects to use it. Col. 2 lines 40-44. The flowcharts of the Goldwasser patent (Figs. 6A-9C) disclose that the Goldwasser invention generally operates as follows: the user enters a keystroke; the invention concatenates the keystroke to previous keystrokes in a buffer; the invention tests for a delimiter (step 112); if a delimiter is found, the system compares the characters in the buffer to a stored sequence (step 114); then an associated pointer is used to find a corresponding abbreviation (step 116) which is then demonstrated to the user by highlighting the characters of the abbreviation, beeping, or pronouncing characters (step 118). The user does not "select" a word in the text in this disclosed method of operation. The American Heritage Dictionary, Second College definition defines "select" as follows:

To choose from among several; pick out; to make a choice or selection.

The drawings of Goldwasser (Figs. 1-5) show that the user is merely making data entry to existing text, not selecting a word in the existing text to be converted. In other words, the user does not choose from among several existing words or pick out a word from the existing text to be converted to an abbreviation. The only word that can be converted by Goldwasser is the single word that the user is currently entering.

Claim 1 is therefore allowable.

Claims 2-14 contain additional elements or limitations beyond allowable claim 1 and are also allowable.

Regarding claims 3-6, Ichbiah does not select a word in the text to be converted to an abbreviation using a keyboard or a mouse. Col. 3 lines 63-65 only teaches displaying a list of

words that have already been converted from abbreviations to the user for selection, in the event that more than one word corresponds to a given abbreviation. Ichbiah only converts abbreviations to words, not vice-versa, and therefore does not teach converting words to abbreviations.

Further as to claim 7, the references do not disclose a step of scanning the text for words to be converted to abbreviations and converting words selected by the data processing method to corresponding abbreviations using the first data structure.

Regarding claim 13, at page 3 of the Office Action, the Examiner states "Ichbiah does not explicitly disclose storing in memory a first data [structure] encoding a plurality of words and corresponding abbreviations." Therefore, the statement in the last full paragraph on page 6 of the Office Action is self-contradictory ("Ichbiah discloses selecting an abbreviation from the first data structure (abstract; col. 3 lines 50-65)..."). In any case, this is not the teaching of col. 3 lines 50-65. Rather, the teaching is of choosing one of a set of matching words generated from an abbreviation, not selecting the abbreviation and inserting the abbreviation into the text at a position selected by the user.

Regarding claim 15, the references do not show the step:

b) the user instructing the data processing method to select a position in the text for insertion of an abbreviation...

The Office Action states that "independent claim 15 includes the same limitations as in claims 1, 9-10, and 13-14, and is rejected on the same rationale." However, the only rejection that addresses step b) is found in claim 13, which has already been shown to be allowable as discussed above. Therefore, claim 15 is also allowable. Claim 16 contains additional elements or limitations beyond allowable claim 15 and is also allowable.

The Office Action rejects claims 17 and 22 under the same rationale as method claims 1, 9-10, and 13. Since claims 1, 9-10, and 13 have been shown to be allowable, and the Office Action has not interposed any additional basis for disallowing claims 17 and 22, claims 17 and 22 are allowable.


The Office Action rejects claims 18-22 under the same rationale as method claims 7-8, 11-12. Since claims 7-8 and 11-12 have been shown to be allowable, and the Office

Action has not interposed any additional basis for disallowing claims 18-22, claims 18-22 are allowable.

For the above reasons, Applicant respectfully requests the allowance of all claims and the issuance of a Notice of Allowance.

Dated: 7/27/04

Respectfully submitted,

By 
Nelson R. Capes (Reg. No. 37,106)
BRIGGS AND MORGAN
2200 IDS Center
80 South Eighth Street
Minneapolis, MN 55402
Telephone: (612) 977-8486